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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/748,857	12/28/2000	Takafumi Ito	04329.2492	6075

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EXAMINER

LEE, JOHN J

ART UNIT	PAPER NUMBER
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2684

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/748,857

Applicant(s)

ITO, TAKAFUMI

Examiner

JOHN J LEE

Art Unit

2684

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments/Amendment

1. Applicant's arguments/amendments received on March 21, 2005 have been carefully considered but they are not persuasive because the teaching of all the cited reference reads on all the rejected claims as set forth in the pervious rejection. Therefore, the finality of this Office Action is deemed proper.

Contrary to the assertions at pages 2 - 5 of the Arguments, claim 8 is not patentable.

During examination, the USPTO must give claims their broadest reasonable interpretation.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Talvitie et al. (US Patent number 6,133,884) teaches data processing apparatus comprises first antenna, second antenna, and PCMCIA card (IC card), and the PCMCIA and antenna units are operatetly connected together for incorporating transferring data each other as the PCMCIA card is plugged in the antenna units. Also, Klatt et al. (US Patent number 5,877,488) teaches PCMCIA card is inserted to a slot in the PCMCIA case to incorporate connecting with antenna. More specifically, for combining teaching of Talvitie and Klatt,

the PCMCIA card to insert to the slot in PCMCIA card case incorporates connecting with antenna units for communicating data. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Talvitie as taught by Klatt, provide the motivation to enhance IC card protection in data processing device.

Re claim 8: Applicant argues that the combination of Talvitie and Klatt do not teach the claimed invention “a first antenna terminal configured to connect the antenna to a second antenna terminal incorporated in the IC card when the IC card is inserted in the card slot”. However, The Examiner respectfully disagrees with Applicant’s assertion that the Talvitie and Klatt do not teach the claimed invention. Contrary to Applicant’s assertion, the Examiner is of the opinion that Talvitie teaches data processing device comprises first antenna, second antenna, and PCMCIA card (IC card) (see Fig. 5), and the PCMCIA are operatetly connected with first antenna and second antenna for incorporating transferring data each other **as the PCMCIA card is plugged in the antenna units** (see Fig. 5 and column 5, lines 66 – column 6, lines 60). Also, Klatt teaches PCMCIA card is inserted to a slot in the PCMCIA case to incorporate connecting with antenna and data transferring each other (see Fig. 1 and column 4, lines 66 – column 5, lines 56), regarding the claimed limitation. More specifically, for combining teaching of Talvitie and Klatt, the PCMCIA card inserting to connect with incorporating the slot in PCMCIA card case performs electrically connecting with antenna units to transfer data. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Talvitie as taught by Klatt, provide the motivation to enhance IC card protection in data processing device.

Applicant's attention is directed to the rejection below for the reasons as to why this limitation is not patentable.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 8 – 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Taivitie et al. (US Patent number 6,133,884) in view of Klatt et al. (US Patent number 5,877,488).

Regarding **claim 8**, Taivitie discloses that a data processing apparatus (column 3, lines 5 – 63 and Fig. 5). Taivitie teaches that an antenna (40 or 30 in Fig. 5). Taivitie teaches that a first antenna terminal (43 through 51 in Fig. 5) configured to connect the antenna to second antenna terminal (30 through 55 in Fig. 5) incorporated in the IC card when the IC card is inserted in the slot (Fig. 5 and column 5, lines 66 – column 6, lines 38, where teaches there are two antenna connection terminals with two antenna operating together in IC card and the first antenna connection terminal implemented to second antenna connection terminal).

Taivitie does not specifically disclose the limitation “a casing having a card slot for inserting an IC card”. However, Klatt discloses the limitation “a casing having a card slot for inserting an IC card” (Fig. 1 and column 4, lines 66 – column 5, lines 56, where

teaches PCMCIA card is provided that can be inserted via insertion slot at the insertion guide into a card case). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Taivitie system as taught by Klatt, provide the motivation to achieve enhancing IC card protection in communication system.

Regarding **claim 9**, Taivitie and Klatt disclose the all the limitation, as discussed in claim 1. Furthermore, Taivitie further discloses that the antenna is provided in an eject lever to be operated to eject the IC card (Fig. 5 and column 6, lines 39 – column 7, lines 12, where teaches the antenna can be extended from the slot and the card can be removed from the card slot).

Regarding **claim 10**, Taivitie discloses that the antenna is provided on a surface of the casing (Fig. 5 and column 6, lines 39 – column 7, lines 12).

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

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advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231
Or P.O. Box 1450
Alexandria VA 22313

or faxed (703) 308-9051, (for formal communications intended for entry)

Or: (703) 308-6606 (for informal or draft communications, please label "PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to USPTO Headquarters, Alexandria, VA.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John J. Lee** whose telephone number is (571) 272-7880. He can normally be reached Monday-Thursday and alternate Fridays from 8:30am-5:00 pm. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, **Nay Aung Maung**, can be reached on (571) 272-7882. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

J.L
June 21, 2005


NAY MAUNG
SUPERVISORY PATENT EXAMINER

John J Lee